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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,157	01/18/2002	Sang Bum Kim	LT-0011	3882

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EXAMINER	
NELSON, FREDA ANN	
ART UNIT	**PAPER NUMBER**
3639	

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,157	KIM ET AL.	
	Examiner	Art Unit	
	Freda A. Nelson	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 19-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 19-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is in response to a communication filed July 27, 2005 wherein:

Claims 1-14 and 19-24 are currently pending;

Claims 15-18 have been canceled; and

Claims 1–14 and 19-24 are pending.

Response to Amendment and Arguments

1. Applicant's election with traverse of claims 1-14 and 19-24 in the communication filed July 27, 2005 is acknowledged. The traversal is on the ground(s) that undue searching should not be required. This is not found persuasive because Examiner believes that the restriction is proper since the subcombinations are distinct from each other and are shown to be separately usable. Invention 1 (Claims 1-14) has separate utility such as selecting a first content to buy through the communication network, selecting a second content, combining the first and second content, and determining a price of the third content. Invention I is classified in class 705, subclass 26. Invention II (Claims 15-18) has separate utility such as selecting an advertisement, presenting the advertisement to a user, asking a question about the content of the presented advertisement, receiving a reply to the question, and determining whether the user has viewed the presented advertisement based on the information contained in the received reply. Invention II is classified in class 705, subclass 10. Examiner notes that it would be a serious burden to search both inventions given their separate status in the art as noted above.

2. The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of the nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. Claims 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 27, 2005.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Korea on 01/19/2001. It is noted, however, that applicant has not filed a certified copy of the 01-3105 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

6. The information disclosure statements (IDSs) submitted on 02/23/04 and 11/29/04 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statements are being considered by the examiner. Copies of PTO-1449 are attached hereto.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation "the format" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation "the playback" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an

> international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-7, 10, 12-13, 19-20, and 23-24, are rejected under 35 U.S.C. 102(e) as being anticipated by Kontogouris (US PG Pub. 2002/0082910).

In claims 1-2, 5, and 13, Kontogouris discloses that first the user inputs a request for connection to a particular electronic address, or access to a desired service or content (step 100); next, in the case of a proxy advertising server, the request is forwarded to the advertising server (step 110); and in some systems, the request may reach the destination server first, and then be forwarded to the advertisement proxy, or the proxy step may be entirely eliminated and the method may, after the request has been sent and received, directly display one or more interactive banner advertisements (step 120) (paragraph 0054). Kontogouris further discloses that correct responses to advertisements are used as the basis for awarding the user a premium for viewing and correctly responding to the advertisements; and the premium may be in the form of credits applied against subscription fees for the requested service, or any other premium such as time credits on access charges to an Internet service provider or cellular telephone service, electronic coupons, free downloads, and so forth (paragraph 0026). Kontogouris still further discloses a price of the third content and a second price of the first content (FIG. 9).

In claim 3, Kontogouris discloses that the system has the ability to give users the choice to defer viewing ads for a subsequent moment and thus complete the transaction at a later time when credit for viewing the ad will be passed on to the user, or to accumulate credits for in advance by viewing ads in blocks before seeking access to an electronic address, service, or content to which the credits will apply (paragraph 0030).

In claim 4, Kontogouris discloses that the banner advertisement that appears in step 270 may of course take a variety of forms, including banner advertisements in multimedia format (paragraph 0064).

In claim 6, Kontogouris discloses a banner ad system which offers discounts for those willing to view banner ads (paragraph 0018).

In claim 7, Kontogouris discloses that the system may be applied to multiple services from different providers at different addresses, sites, or locations, in which case a credit system that can be applied by an individual to any one of the numerous available services or destinations may be used (paragraph 0029).

In claim 10, Kontogouris discloses that when the service request is received at the banner advertisement server 3, the banner advertisement server sends a banner advertisement to the requester's computing device (paragraph 0052; FIG. 4). Kontogouris further discloses that in the case of the embodiment of FIG. 5, the gateway server 3' supplies the service or content 4' to the user's computing or communications device through the appropriate wired or wireless network (paragraph 0052).

In claims 12 and 23-24, Kontogourus discloses that the conventional definition of "banner advertisement" refers to advertisements that appear as a box on a web page display screen, that may contain text, images, animation, sound, video, and/or other effects, and that includes hyperlinks to the advertiser's website. Kontogourus further discloses that those skilled in the art will appreciate that the term "banner advertisement" as used herein is not intended to be limited to advertisements that include hyperlinks to the advertiser's website, or to advertising on the Internet that may include a variety of interactive features, and that may appear in connection with any electronic medium or network, including wireless and digital television media or networks, that permits interactivity between the user's computing or communications device and remote service or content provider (paragraph 0025). Kontogourus still further discloses that the banner advertisement may include any combination of text, graphics, video, sound, and/or animation (paragraph 0062). Kontogouris still further discloses that first the user inputs a request for connection to a particular electronic address, or access to a desired service or content (step 100); next, in the case of a proxy advertising server, the request is forwarded to the advertising server (step 110); and in some systems, the request may reach the destination server first, and then be forwarded to the advertisement proxy, or the proxy step may be entirely eliminated and the method may, after the request has been sent and received, directly display one or more interactive banner advertisements (step 120) (paragraph 0054). Kontogouris still further discloses a price of the third content and a second price of the first content (FIG. 9).

In claims 19-20, Kontogouris discloses that first the user inputs a request for connection to a particular electronic address, or access to a desired service or content (step 100); next, in the case of a proxy advertising server, the request is forwarded to the advertising server (step 110); and in some systems, the request may reach the destination server first, and then be forwarded to the advertisement proxy, or the proxy step may be entirely eliminated and the method may, after the request has been sent and received, directly display one or more interactive banner advertisements (step 120) (paragraph 0054). Kontogouris further discloses that correct responses to advertisements are used as the basis for awarding the user a premium for viewing and correctly responding to the advertisements; and the premium may be in the form of credits applied against subscription fees for the requested service, or any other premium such as time credits on access charges to an Internet service provider or cellular telephone service, electronic coupons, free downloads, and so forth (paragraph 0026). Kontogouris still further discloses a price of the third content and a second price of the first content (FIG. 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kontogouris (US PG Pub. 2002/0082910) in view of Stern (US PG Pub. 2001/0052001).

In claims 8-9, Kontogouris does not disclose that the third content is stored in a recording medium to be delivered to a buyer. Kontogouris does not further disclose that the recording medium is one of a CD, a DVD, a FDD, a HDD, and a memory. Stern discloses that that a new digital content distribution network is presented, providing commercial sales outlets of a commercial entity expanded bandwidth for delivery of video, audio, graphics, text, data, and other types of information streams within (and also, optionally, outside of) these commercial sales outlets (paragraph 0019). Stern further discloses that content is preferably procured by the entity operating a network management center 110 (NMC 110) via traditional recorded media (tapes, CD's, videos, and the like)

wherein content provided to NMC 110 is compiled into a form suitable for distribution to and display at the commercial sales outlets being supplied (paragraph 0027). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Stern in order to promote electronic distribution.

In claim 11, Kontogouris does not disclose that the third content is formatted as MPEG data. Stern discloses that DDS 100 is a system employing a combination of software and hardware that provides cataloging, distribution, presentation, and usage tracking of music recordings, home video, product demonstrations, advertising content, and other such content, along with entertainment content, news, and similar consumer informational content in an in-store setting wherein this content includes content presented in MPEG1 and MPEG2 video and audio stream format, although the present system should not be limited to using only those formats (paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Stern in order to provide a the user a variety of content to view.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kontogouris (US PG Pub. 2002/0082910) in view of Miyashita (US PG Pub. 2001/0014876).

In claims 14 and 21-22, Kontogouris does not disclose combining the first and second content to form a third content. Miyashita discloses that the system is constructed with the assumption that a general consumer views and/or listens to an advertisement attached to desired music/video content when he/she views and/or listens to the music/video content, therefore, it is undesirable to allow separation of the advertising content from the music/video content or to allow the consumer to skip the advertisement during playback of the music/video content (paragraph 0071). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Miyashita in order to provide a technique to prevent separation or skipping of the advertising content (Miyashita; paragraph 0071).

Conclusion

12. The examiner has cited prior ad of interest, for example:

1) Cohen et al. (US Pg Pub. 2001/0021915), which disclose a compensation driven network based exchange system and method.

2) Downs et al. (Patent Number 6,226,618), which disclose an electronic content delivery system.

3) Spagna et al. (Patent Number 6,587,837), which disclose a method for delivering electronic content from an online store.

4) "Wired and Kodak Team-up for 12-Month Cross-Media Advertising Push", Jan. 19, 1998, PR Newswire. New York: pg. 1.

5) "Rich Media Advertising Just Got Richer: Announcing the launch of Zebus", Jan. 9, 2001, Business Wire. New York: pg. 1.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 09/12/2005

JOHN W. HAYES
PRIMARY EXAMINER